

Appln. No.: 10/049,274  
Amendment dated November 19, 2004  
Reply to Office Action of May 20, 2004

### **REMARKS/ARGUMENTS**

The office action of May 20, 2004 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested.

Claims 1 and 3 remain in this application.

It is unclear what priority claim the Office Action is referring to in paragraph 1. The application was filed originally as a PCT application; thus there is no domestic priority. Moreover, it is not clear what is meant regarding prior application No. 10/134,754, filed 4/30/02 or why the Office Action is considering application serial no. 10/049274 filed 9/5/02 to be a priority application. Applicant is not claiming priority to either of these applications. Paragraph 2 of the Office Action is very confusing. Clarification is respectfully requested.

The instant application was filed 2/11/02 and the PCT application was filed 8/10/99. The specification was previously amended in a preliminary amendment to include a statement regarding the PCT application. It is believed all requirements have been satisfied.

Claim 1 stands rejected under 35 U.S.C. 101. Claim 1 has been amended as a method claim. Withdrawal of this rejection is requested.

Claims 1-4 stand rejected under 35 U.S.C. 112, first paragraph. The utility of remaining claims 1 and 3 is clear, i.e. the compounds are used for the treatment of bacterial infections. One skilled in the art would know how to make the compounds listed in claim 1 based on the instant specification and further it is well within the skill of the art to administer such compounds. Withdrawal of this rejection is requested.

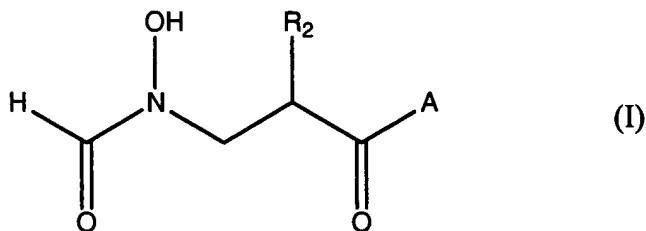
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Claims 1-4 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite. Claim 1 has been amended to delete the formulas and provide a recitation of specific compounds; hence the rejection is fairly moot. The Office Action's position regarding what is excluded in claims 2 and 3 is not understood. Claim 2 (now part of claim 1) recites that the antibacterial compounds are administered and claim 3 requires that the administration occur at the site of contamination. Thus claim 3 further limits claim 1. Withdrawal of this rejection is requested.

Claims 2 and 3 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The compounds are antibacterial agents and thus inhibit the growth of bacteria. Methods of testing for antibacterial activity are well known and trivial. The specific compounds have specific structures and their syntheses are described in the specification. Pharmaceutically and veterinarily acceptable salts, hydrates, or solvates are standard and acceptable within the art. It is therefore not clear what is missing from the teaching of the specification which prevents the skilled man from practicing the invention. The legal requirements of enablement are completely satisfied. Withdrawal of this rejection is requested.

Claims 1 and 4 stand rejected as failing to comply with 37 CFR 1.141(a). At the outset, the limitation of claim 2 was inserted into claim 1; hence the rejection is moot. Furthermore, this rejection is respectfully in error. Amended claim 1 is a generic claim. It is directed to a method of treating bacterial infections using the listed compounds. The compounds all have a similar core structure, namely:



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Different compounds can have different molecules, but separate applications do not need to be filed for each separate compound. There is no evidence that 25 is an unreasonable number, particularly when the structures of the compounds are similar. Attention is drawn to the examples in the instant specification which demonstrate the structural similarity. Moreover, the Office Action could have required an election of species.

In addition, it is not clear what "critical limitations" the Office Action is referring to. Clarification is respectfully requested.

Claims 1-4 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of Hunter et al. (U.S. Patent No. 6,423,690) and claims 1-16 of Hunter et al. (U.S. Patent No. 6,441,042). As suggested, enclosed herewith are Terminal Disclaimers. Withdrawal of this rejection is requested.

Claims 1-4 stand rejected under under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-43 of co-pending Application No. 10/134,754. As suggested, enclosed herewith is a Terminal Disclaimer. Withdrawal of this rejection is requested.

Claims 1-4 stand rejected under 35 U.S.C. 102(b) as being anticipated by Fournie-Zaluski et al. (J.Med.Chem. 28, 1158-69 (1985)). Fournie-Zaluski does not teach any of the compounds listed in claim 1 nor their use in the treatment of bacterial infections. Thus, Fournie-Zaluski cannot anticipate the instant claims. Withdrawal of the instant rejection is requested.

Claims 1-4 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/38705. Claims 1-4 stand rejected under 35 U.S.C. 102(b) as being anticipated by Handa et al. (U.S. Patent No. 4,996,358). Handa does not teach any of the compounds listed in claim 1 nor their use in the treatment of bacterial infections. Thus, Handa cannot anticipate the instant claims. Withdrawal of the instant rejection is requested.

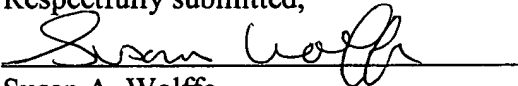
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Claims 1-4 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/10990. WO 94/10990 does not teach any of the compounds listed in claim 1 nor their use in the treatment of bacterial infections. Thus, WO 94/10990 cannot anticipate the instant claims. Withdrawal of the instant rejection is requested.

Claims 1-4 stand rejected under 35 U.S.C. 102(b) as being anticipated by Jin et al. (Bioorg. Med. Chem. Letters 8/24, 1158-69(1998)). Jin does not teach or suggest any of the compounds listed in claim 1 nor their use in the treatment of bacterial infections. Thus, Jin cannot anticipate the instant claims. Withdrawal of the instant rejection is requested.

### **CONCLUSION**

In view of the above amendments and remarks, withdrawal of the objections and rejections and issuance of a Notice of Allowance are requested.

Respectfully submitted,  
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